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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,277	05/30/2001	Carsten Thormod Pedersen	P 282898 2980651US/HS/H	7410
909	7590	10/15/2003	EXAMINER	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			KARMIS, STEFANOS	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/870,277

Applicant(s)

PEDERSEN ET AL.

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The following application has been reviewed. Original claims 1-14 are pending. The rejection is as stated below:

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, and 5-13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Martin et al. (hereinafter Martin) U.S. Patent 5,909,485.

Regarding independent claim 1, Martin discloses a method for updating a subscriber's account credit in a telecommunications system where at least two different types of vouchers can be used for making deposits in the account by defining at least two different ways of updating the credit, maintaining information indicating the type of a first voucher currently used, receiving a deposit identifying a second voucher, determining the type of the second voucher (column 5, lines 1-36); and selecting the way of updating the credit on the basis of the types of the first voucher and the second voucher (column 8, line 40 thru column 9, line 32).

Claim 2, checking whether the first voucher and the second voucher are of the same type, and updating the credit by adding the value of the second voucher to the credit, if said vouchers

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are of the same type, or updating the credit by setting the credit to be the value of the second voucher, if said vouchers are of different types (column 8, line 40, thru column 9, line 32).

Claim 5, the subscriber asks for permission to update the credit, if the vouchers are of different types and updating the credit only if permission is granted (column 10, lines 53 thru column 11, lines 6).

Claim 6, the types of vouchers being used, are determined on the basis of their identification numbers (column 5, lines 1-36).

Claim 7, the telecommunications system is a mobile telecommunications system (column 3, lines 20-47).

Regarding independent claim 8, Martin discloses a method for updating a subscriber's account credit in a telecommunications system where at least two different types of vouchers can be used for making deposits in the account by defining at least two different ways of updating the credit, maintaining information indicating the type of a first voucher currently used, receiving a deposit identifying a second voucher, determining the type of the second voucher (column 5, lines 1-36); and selecting the way of updating the credit on the basis of the types of the first voucher and the second voucher (column 8, line 40 thru column 9, line 32).

Claim 9, the subscriber asks for permission to update the credit, if the vouchers are of different types and updating the credit only if permission is granted (column 10, lines 53 thru column 11, lines 6).

Claim 10, the arrangement is arranged to detect said change of voucher type by determining the types of a last used voucher and a new voucher and by comparing these types (column 5, lines 1-36).

Claim 11, the arrangement comprises an Intelligent Peripheral of an Intelligent Network, said Intelligent Peripheral comprising an Interactive Voice Response service through which the credits are updated (column 6, lines 13-31).

Regarding independent claim 12, Martin discloses a method for updating a subscriber's account credit in a telecommunications system where at least two different types of vouchers can be used for making deposits in the account by defining at least two different ways of updating the credit, maintaining information indicating the type of a first voucher currently used, receiving a deposit identifying a second voucher, determining the type of the second voucher (column 5, lines 1-36); and selecting the way of updating the credit on the basis of the types of the first voucher and the second voucher (column 8, line 40 thru column 9, line 32).

Claim 13, the subscriber asks for permission to update the credit, if the vouchers are of different types and updating the credit only if permission is granted (column 10, lines 53 thru column 11, lines 6).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 3-4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (hereinafter Martin) U.S. Patent 5,909,485 in view of Katz et al. (hereinafter Katz) U.S. Patent 6,424,706.

Claim 3 and 14, Martin teaches checking types of vouchers being used for prepayment and updating the credit by adding the value of the second voucher to the credit, if the vouchers are of the same type (column 8, line 40 thru column 9, line 32). Martin fails to teach determining a factor, multiplying the credit with the factor and adding the result of the said multiplication to the value of the second voucher, and setting the credit to be the result of said addition, if the vouchers are of different types. Katz teaches a system and method that addresses the notion of "unit-minutes", wherein unit-minutes are priced in the local currency of the country where the customer acquires the service and are generally related to the price of other minute types, such as local, long distance and international minutes within the same, and among different companies by a "unit-minute to telecommunication minute" conversion factor (column 5, lines 25-50). Both references teach methods for prepayment options in telecommunication systems that incorporate at least two methods of providing payment. Therefore it would have been obvious to one skilled in the art, that minute or price conversion factors as taught by Katz could be modified into the teachings of Martin for different types of prepayment options to develop a standard so that any type can be accepted and quickly turned into usable minutes and able to incorporated into the already existing balance.

Claim 4, Katz teaches factor is determined on the basis of the first and second voucher or types of minutes purchased (column 5, lines 51-67).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Fournies et al., US Patent 5,854,975 Dec. 29, 1998. Prepaid security cellular telecommunications system.
- b) Taskett, US Patent 5,991,748 Nov. 23, 1999. Methods and apparatus for regenerating a prepaid transaction account.
- c) Martineau, US Patent 6,415,142 Jul. 2, 2002. Prepaid smart card in a GSM based wireless telephone network and method for operating prepaid cards.
- d) Rahman et al., US Patent 6,036,090 Mar. 14, 2000. Automated prepayment method for mobile terminals.
- e) Frisk, US Patent 6,430,406 Aug. 6, 2002. Credit information in a mobile phone.
- f) Despres et al., US Patent 6,434,379 Aug. 13, 2002. Method for dynamic management of a prepaid terminal subscription.
- g) Laybourn et al., US Patent 6,625,439 Sep. 23, 2003. System and method for managing prepaid wireless service.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

Respectfully Submitted
Stefano Karmis
October 6, 2003



HANI M. KAZIMI
PRIMARY EXAMINER